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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
09/980,573	02/06/2002	Harald Genger	22054	5984
535	7590	10/20/2004	EXAMINER	
THE FIRM OF KARL F ROSS 5676 RIVERDALE AVENUE PO BOX 900 RIVERDALE (BRONX), NY 10471-0900			FOREMAN, JONATHAN M	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/980,573

Applicant(s)

GENGER ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004 and 19 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: Page 6, lines 4 – 5 state “shows a illustrates”.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 17, 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,171,258 to Karakasoglu et al.

In reference to claims 17, 18, and 19, Karakasoglu et al. discloses an electrode device having at least two electrodes engagable with the forehead region (Col. 5, lines 4 – 17), a measuring circuit arrangement for producing data in accordance with the electrical potentials detected by the electrode device, characterized in that the circuit is partially integrated into a forehead support element (Col. 2, lines 27 – 31), and there is a signal transmission device for cord-less transmission of the data produced by the measuring circuit (Col. 4, lines 58 – 63). Karakasoglu et al. discloses a measurement data recording device for recording measurement data produced by the measuring circuit arrangement. Karakasoglu et al. discloses a data compression device for forwarding compressed data (Col. 5, line 57 – Col. 6, line 27).

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 5, 7 and 9 -16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,119,693 to Kwok et al. in view of U.S. Patent No. 6,171,258 to Karakasoglu et al.

In reference to claims 1 – 5, 7 and 9 - 16, Kwok et al. discloses a mask member (Figures 1 - 4) that engages over the nose region of a patient, a sealing device (Figure 4) for sealing off an inner region of the mask with respect to the ambient atmosphere (Col. 1, lines 23 – 24), and a forehead support element (10) for supporting the mask member in the forehead region of the patent (Col. 2, lines 57 – 61). The position of forehead support element is established in conjunction with the position of the mask device. The forehead support element is coupled to the mask device and integral with the mask device (Col. 2, lines 56 – 67). The forehead support material comprises an elastomer material (Col. 3, lines 19 - 22). Kwok et al. discloses a stiffening element that couples the forehead support element (Col. 3, lines 5 – 14) and the mask device. Kwok et al. discloses the mask for being used to treat and prevent sleep disorders (Col. 1, lines 11 – 16). However, Kwok et al. fails to disclose the forehead support element having an electrode device for detecting brain-electrical potentials of a patient. Karakasoglu et al. discloses a forehead support element having at least two electrode elements for detecting brain-electrical potentials of a patient (Col. 5, lines 18 – 22). It would have been obvious to one having ordinary skill in the art to modify the forehead support device as disclosed by Kwok et al. to include an electrode device and measuring circuit for detecting

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brain-electrical potentials as taught by Karakasoglu et al. in order to diagnose sleep disorders and to ascertain sleep staging of a patient (Col. 5, lines 1 – 6).

6. Claims 1, 2, 4, 7, 9, 11, 12, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,199,550 to Wiesmann et al. in view of U.S. Patent No. 6,167,298 to Levin.

In reference to claims 1, 2, 4, 7, 9, 11, 12, 15, 17 and 19, Wiesmann et al. discloses a device worn by emergency personnel (Figure 3) with a sensor device applied to the forehead region of the patient (Col. 5, lines 25 – 27), where the sensor device is arranged on a forehead support element (50) that co-operates with a breathing mask device in a way that the position of the sensor device is established in conjunction with the application position of the breathing mask device. The forehead support element (50) is coupled to the mask device and is integral with the mask. The forehead support element is formed in one piece with a mask base member. The sensor device has three sensor elements (20, 22, 70). The sensor elements are coupled to a signal processing device (Col. 5, lines 62 – 67). A sealing device seals off an inner region of the mask (Col. 5, lines 28 – 30). Wiesmann et al. discloses a sensor device (20, 22, 70), a measuring circuit arrangement for producing data in accordance with the measured values (Col. 5, lines 62 – 67) detected by the sensor device, characterized in that the circuit is partially integrated into a forehead support element (Col. 5, lines 25 – 27), and there is a signal transmission device for cord-less transmission of the data produced by the measuring circuit and a data recording device (Col. 13, line 55 – Col. 14, line 33). However, Wiesmann et al. fails to disclose the sensor elements being electrode elements for detecting brain electrical potentials. Levin discloses a device having electrode elements (10) worn against the forehead region of a user (Col. 4, lines 39 – 42) for detecting brain electrical potentials (Col. 4, lines 37 – 39). It would have been obvious to one having ordinary skill in the art at the time the invention

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was made to replace the sensors as disclosed by Wiesmann et al. with electrodes to detect brain potentials as taught by Levin in order to allow monitoring of an emergency personnel's brain wave patterns to determine if the subject is in an alert mental state (Col. 2, lines 17 – 26).

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,119,693 to Kwok et al. in view of U.S. Patent No. 6,171,258 to Karakasoglu et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,479,934 to Imran.

In regards to claim 8, Kwok et al. in view of Karakasoglu et al. fail to disclose the electrodes being mounted on a surface to yield in a direction perpendicular to the application surface. However, Imran discloses a device having EEG electrodes and mounting the electrodes on a surface that yields in a direction perpendicular to the application surface (Col. 7, lines 10 – 14). It would have been obvious to one having ordinary skill in the art at the time the invention was made to mount the electrodes as disclosed by Kwok et al. in view of Karakasoglu et al. on a surface as taught by Imran in order to retain the electrodes in contact with the head of the patient.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,171,258 to Karakasoglu et al. in view of U.S. Patent No. 6,230,049 to Fischell et al.

In regards to claim 20, Karakasoglu et al. discloses a measurement data recording device (Col. 4, line 48), but fails to disclose the data recording device being an approximately postage stamp-size memory card element that is releasably fitted. Fischell et al. discloses a wireless EEG monitoring system wherein the data recording device is an approximately postage stamp-size memory card element that is releasably fitted (Col. 63 – 64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the data recording device as disclosed by Karakasoglu et al. to be an approximately postage stamp-size memory card

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element that is releasably fitted as taught by Fischell et al. in order to store large amounts of data (Col. 6, lines 60 – 63).

### *Response to Arguments*

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,032,934 to Brown and U.S. Patent No. 5,353,788 to Miles.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

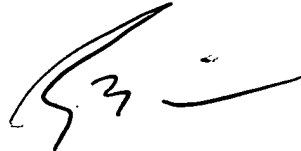
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703) 305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703)308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JMLF

  
ERIC F. WINAKUR  
PRIMARY EXAMINER